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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,401	02/06/2002	Helen Bucknall	FBRIC25.001AUS	4791

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/072,401	Applicant(s) BUCKNALL ET AL.	
	Examiner Binh-An D. Nguyen	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination filed June 6, 2005 has been approved. Further, the Amendment filed June 6, 2005 has been received. According to the Amendment, claims 2 and 10 have been canceled; claims 1, 3-5, and 9 have been amended; and new claims 14-24 have been added. Currently, claims 1, 3-9, and 11-24 are pending in the application. Acknowledgment has been made.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is vague and indefinite since its scope is unclear. Note that, if the applicant intend to claim a program to generate the game display, it must contain method steps executable by a computer processor.

Claim Rejections - 35 USC §101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 18, 22-24 are rejected under 35 U.S.C. 101. The analysis of whether an invention is non-Statutory is a two-prong test. First, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fails to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Second, the claimed invention must produce a useful, concrete, and tangible result. See, *State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373, 47USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In this case, claim 18 includes a program to generate on a gaming machine screen display. The program does not provide computer-executable steps embedded in a computer readable medium, and further, it is merely a video presentation, are considered nonstatutory descriptive material since there is no computer-readable medium to realize the functionality of the computer-executable steps to be presented on the display. Thus, there is no concrete, tangible result.

Further, claims 22-24 is a still picture because nothing in the body of the claim provide a process to generate the game display.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Aristocrat Leisure Industries (WO 99/64997).

WO 99/64997 teaches a gaming machine display comprising: a background scene for a game scene of a spinning reel game; a representation of a plurality of spinning reels, each reel comprising a set of composite symbols at least one including a transparent carrier portion and a game symbol portion, wherein said composite symbols are displayed to overlie said background scene and wherein said background scene is at least partially viewable through said carrier portions (figs. 4a and 4b); and at least one pay line identified, game symbol portions displayed on said at least one pay line defining a winning or a losing outcome (page 2, line 9 to page 3, line 30); said transparent carrier of adjacent composite symbols cooperate to define a transparent reel overlying said background scene and wherein the background scene is viewable through said transparent reel; and highlighting the game symbol portion of any composite symbol on a pay line for a winning combination. Note that, claims 22-24, as claimed, is broadly interpreted as a picture.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-9, and 11-21, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aristocrat Leisure Industries (WO 99/64997) in view of Buxton et al. (6,118,427).

Regarding claims 1, 3, 4, 5, 7, 9, 16-19, 20, and 21, WO 99/64997 teaches method (and system thereto) for enhancing a screen display of a gaming machine comprising: creating a background scene for a game screen of a spinning reel game; creating a video representation of a plurality of spinning reels, each reel comprising a set of composite symbols defining active components of the spinning reel game which are spun up on the reels to provide for various combinations of the composite symbols, at least one of the combinations being a winning combination wherein the composite symbols overlies the background scene (formed by plurality of symbols randomly selected and displayed animated line, page 2, lines 9-32); composite symbols comprises a carrier portion and a game symbol portion, rendering at least the carrier portions of certain of the composite symbols transparent to enable the background scene to be viewed through the carrier portions of the composite symbol (background of footsteps including the transparent portion of the footsteps) (i.e., the transparent portion between the shoe and the heel of the footsteps, figs.4a-4c).

WO 99/64997 does not explicitly teach the limitations of: wherein the composite symbols of each reel are arranged end-to-end such that the carrier portions of the at least certain composite symbols define in combination a transparent reel strip portion through which the underlying background scene is viewable (claim 1, 9, and 16-19); rendering the portion of each composite symbol transparent by a software

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implementation (claim 3); setting the portion of each composite symbol to an appropriate alpha channel value in an alpha channel range to achieve transparency of the portion of each composite symbol (claim 4); employing an objects based graphics system for development of the composite symbol with portions of the composite symbol being rendered opaque (claim 5); placing a part of the background scene over the composite symbol (claim 7). Buxton et al., however, teaches a graphical user interface comprising the limitations of the composite symbols arranged end-to end (Fig. 1); rendering the portion of each composite symbol transparent by a software implementation (see the abstract and 3:36-4:56); producing transparency levels, alpha blending (11:1-12:67; 16:63-17:33); employing an objects based graphics system for development of the composite symbol (non-surface components 1404) with portions of the composite symbol (non-surface components 1404) being rendered opaque (14:1-14). Buxton et al, further teaches rendering at least a portion of each non-surface components 1404 transparent to enable the background scene to be viewed through the composite symbol (Figures 1, 2, and 14). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize Buxton et al. 's graphical user interface to generate graphics for the gaming system and method of WO 99/64997 to come up with a gaming machine having attractive graphical affects thus attract more players and increase profit.

Note that, the term "carrier" is considered as the background of each symbol or the symbol's bounding box.

Further, note that, the limitations of placing a part of the background scene over the composite symbol (claim 7), e.g., switching graphic layers to create animation effects such as flashing; and setting the portion of each composite symbol to an appropriate alpha channel value in an alpha channel range to achieve transparency of the portion of each composite symbol (claim 4), e.g., setting the alpha channel of a graphic to certain desired ranges to control the transparency level of certain designed graphic are notoriously well known in the graphic design industry. See also, Buxton et al.'s 2:32-3:19.

Regarding claims 6, 8, 11, and 12, WO 99/64997 further teaches causing the composite symbol itself to be flashed on and off directly on top of the underlying part of the background scene so that the background scene remains visible and any background animations continue while the composite symbol (animated line) flashes; placing a flashing composite symbol animation (animated line) on top of the part of the background scene (formed by plurality of symbols randomly selected and displayed) to provide a flashing composite symbol.

Furthermore, it is notoriously well known in the game industry to use transparency graphics, e.g., transparent GIF, animated GIF, or transparency graphics setting from different graphical user interface (GUI) packages.

9. Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive.

Applicant's argument regarding Aristocrat (WO 99/64997) and Buxton et al. not teaching a symbol with transparent part (applicant's remarks, page 9, first paragraph) is not persuasive. Aristocrat does teach the symbol of footsteps each having transparent portion, i.e., the transparent part between the heel and the toe (Fig. 4a); and Buxton teaches a graphical generating system and method having transparency adjustments having composite symbols arranged end-to end (Fig. 1). Thus, it would have been obvious to provide the graphic generating technique of Buxton to the symbols and background scenes of Aristocrat's video gaming machine to enhance graphical affects of the game.

Further, applicant's remark regarding the amended features of "*composite symbols which define active components of the spinning reel game to provide for various combinations of the composite symbols at least some of the combinations being winning combinations and wherein at least certain of the at least carrier portions are rendered transparent to enable a back ground scene to be viewed through the carrier portion*" (applicant's remarks, page 9, last paragraph) is met by the combination of Aristocrat (WO 99/64997) and Buxton et al. Note that, by modifying the composite symbols of Aristocrat using the composite layers arrangement of Buxton et al. would result in various combinations of the composite symbols at least some of the combinations being winning combinations and wherein at least certain of the at least carrier portions are rendered transparent to enable a back ground scene to be viewed through the carrier portion as claimed by the applicant.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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